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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/010,158 | 11/13/2001 | Earl J. Votolato | SPELL-004C | 8649 |
| 34284 | 7590 | 01/08/2004 | EXAMINER | |
| ROBERT D. FISH; RUTAN & TUCKER, LLP P.O. BOX 1950 611 ANTON BLVD., 14TH FLOOR COSTA MESA, CA 92628-1950 | | | DRUAN, THOMAS J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |
| DATE MAILED: 01/08/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/010,158 | VOTOLATO, EARL J. | |
| | Examiner | Art Unit | |
| | Thomas J. Druan, Jr. | 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This action is in response to Applicant's amendment received on 02 October 2003.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 & 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen.

Chen discloses the invention as claimed including first and second arms having exterior surfaces extending concavely from a common bridge (as seen in figures 2 & 3), the first arm carrying a cutting surface on an interior surface facing the second arm; and the second arm carrying a curved receiving surface that cooperates with the cutting surface (as seen in figure 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,007,171 to Horning, Jr. (hereinafter Horning) in view of Chen.

Horning discloses the invention substantially as claimed including a first arm 13 and a second arm 14, each with respective interior and exterior surfaces connected by a bridge, wherein said first arm has a blade 29 integral with the inner surface and wherein said second arm has a receiving surface 28 in the inner surface of the second arm opposing said blade (fig. 7). Horning discloses finger recesses 19 on the outer surface of the second leg, but does not have exterior surfaces of the first and second arms that extend concavely from the bridge. Chen discloses having concavely contoured outer surfaces to enhance manual grasping of the bag opener. It would have been obvious to one skilled in the art at the time of the invention to add the concavely contoured exterior surfaces of Chen on the first and second arms of Horning in order to enhance manual grasping of the bag opener of Horning.

6. Claims 4 & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horning in view of Chen in further view of US 5,103,562 to Braatz (hereinafter Braatz).

The combination of Horning in view of Chen discloses the invention substantially as claimed, but lacks the first and second arms and bridge fabricated as single piece of plastic. Braatz teaches making the arms and bridge of a package opening tool out of a single piece of plastic with a metal blade in the interior surface of one of the arms (column 2, lines 25-30). It would have been obvious to one skilled in the art to make the first and second arms and bridge of Horning in view of Chen as a single piece of plastic

material except for a metal blade in order to simplify manufacture while providing a strong metal blade that resists wear.

7. Claims 4 & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Braatz.

Chen discloses the invention substantially as claimed, but lacks mention that the first and second arms and bridge are fabricated as single piece of plastic, or that the cutting surface is a metal blade. Braatz teaches having the arms and bridge of a package opening tool made out of a single piece of plastic with a metal blade in the interior surface of one of the arms (column 2, lines 25-30). It would have been obvious to one skilled in the art to make the first and second arms and bridge of Chen as a single piece of plastic material except for a metal blade as the cutting surface in order to simplify manufacture while providing a strong metal blade that resists wear.

Response to Arguments

8. Applicant's arguments with respect to claims 1 & 4-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Druan, Jr. whose telephone number is 703-308-4200. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

tjd
tjd
January 6, 2004

T. Boyer Ashley
BOYER ASHLEY
PRIMARY EXAMINER